

REMARKS

Claims 1-7, 9-14, 16, and 18-24 are pending in this application. In this Response, Applicants have amended certain claims in this response because Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 13, and 16 have been rewritten to clarify the invention. In addition, various dependent claims have been amended to maintain consistency with the language now recited in the independent claims. As no new matter has been added by the amendments herein, Applicants respectfully request entry of these amendments at this time.

THE REJECTION UNDER 35 U.S.C. § 112

Claims 13-14, 16, and 18-24 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth on page 2 of the Office Action. In light of the amendments to claims 13 and 16 and 22-24, Applicants respectfully submit that these rejections are overcome. As such, Applicants respectfully request that the § 112 rejection be withdrawn.

THE REJECTION UNDER 35 U.S.C. § 103

Claims 1-7, 9-13, 16, and 18-21 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,574,107 to Hiraoka *et al.* in view of U.S. Patent No. 6,465,573 to Maruko *et al.* for the reasons stated on pages 2-3 of the Office Action. Applicants respectfully submit that the cited combination does not render obvious the present invention.

The primary reference Hiraoka generally discloses a rubber composition that can include *no more than* 45 parts by weight of a vulcanized rubber powder. Col. 3, lines 18-26. In particular, Hiraoka teaches away from amounts generally greater than 35 parts by weight of the vulcanized rubber powder because “the workability during mixing is inferior.” Col. 4, lines 15-21. In an attempt to remedy this deficiency, the Examiner cited Maruko for its disclosure of a golf ball including up to 75 percent of a pre-crosslinked rubber powder. *See* Office Action at Page 3.

Applicants maintain their arguments with respect to the Examiner’s rejection based on this cited combination. *See* Response to Office Action filed September 15, 2005. To

reiterate, “[i]t is improper to combine references where the references teach away from their combination.” See *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). The Examiner attempts to rationalize her rejection by stating that Hiraoka’s “disclosure only teaches away from larger amounts than 35% for manufacturing purposes . . . [and] is silent as to the effects larger amounts of powder will have on the performance of the ball.” Office Action at Page 3. Applicants respectfully submit to the Examiner that a skilled artisan would have had no motivation to use a larger than disclosed amount to test performance issues in light of the teaching away for manufacturing purposes without the instant application to use as a template.

The Examiner appears to state that Maruko is cited merely to show that the range pre-vulcanized or pre-crosslinked materials previously recited in the claims was not new or innovative. Office Action at Page 3. Applicants obviously disagree with the use of this reference to demonstrate a range of materials when the materials used in Maruko differ from both the present invention and the primary reference, *i.e.*, thermoplastic verses thermoset.

Despite the flaws in the Examiner’s rejection, in the interest of expediting allowance of the claims, Applicants have rewritten the pending independent claims to recite a higher amount of material than disclosed in either Hiraoka or Maruko. In particular, the claims of the present invention feature between about 100 and about 200 parts by weight of pre-vulcanized or pre-crosslinked material per 100 parts of a base rubber. Applicants respectfully submit that a skilled artisan would not have found it obvious to increase the amount of material from that disclosed in Hiraoka, even if combined with Maruko, to the amount presently recited in the claims.

For the reasons above, Applicants respectfully submit that neither Hiraoka nor Maruko alone or in combination anticipate or render obvious the present invention. As such, Applicants respectfully request reconsideration and withdrawal of the rejection based thereon.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including March 29, 2006. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0269.

Respectfully submitted,

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